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today was not written for publication and is
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Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAUNDRA TROTT

Appeal No. 2000-2168
Application 09/130,383

ON BRIEF

Before THOMAS, HAIRSTON and GROSS, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's
final rejection of claims 1-3.

Representative claim 1 is reproduce below:

1. A guard to prevent water from splashing on cabinetry including a sink, said cabinetry including a horizontal counter top mounting the sink, vertically disposed cabinet faces disposed below the counter top and a counter top lip projecting forwardly of the cabinet faces, the sink having a near boundary dimension, the guard comprising:

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a panel having a longitudinal dimension substantially co-extensive with the near boundary dimension of the sink, a longitudinally extending, horizontal upper margin to overlay the lip and disposed at an acute angle relative to the panel and a trough at the lower margin to, when the panel is attached to the lip to direct the panel rearwardly to locate the trough adjacent the cabinet faces; and

means for temporarily securing the panel to dispose the upper margin co-extensive and proximate the sink near boundary to position the panel over the cabinetry faces.

The following references are relied on by the examiner:

Gray	1,234,658	July 24, 1917
Piper	1,857,328	May 10, 1932
Laird	4,620,332	Nov. 4, 1986
Carroll	5,381,564	Jan. 17, 1995

Independent claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Piper or Carroll or Gray. Claim 2 stands rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Carroll in view of Laird for one rejection, with an additional rejection based upon Gray in view of Carroll, further in view of Laird.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and the answer for the respective details thereof.

OPINION

For the reasons set forth by the examiner in the answer, we sustain each of the three rejections of independent claims 1 and 3 under 35 U.S.C. § 102 but, on the other hand, we reverse both rejections of dependent claim 2 under 35 U.S.C. § 103.

For each of the rejections of claims 1 and 3 under 35 U.S.C. § 102, the examiner provides detailed correspondence to the elements recited in representative claim 1 as taught and shown in Piper, Carroll and Gray at pages 4-6 of the answer. Inasmuch as we agree with this correspondence, we see no need to repeat the examiner's position here. Similarly, we are in agreement with the examiner's positions set forth at pages 7 and 8 of the answer which are in response to appellant's arguments set forth with respect to these rejections at pages 4-6 of the brief.

Like the examiner, we agree with the examiner's assessment that the subject matter of the independent claims 1 and 3 on appeal essentially sets forth only the claimed guard per se with the other features that are recited in the claims being merely of an intended use. To expand upon this reasoning, we note that in the representative independent claim 1 preamble, the features relating to the cabinetry are recited in the present tense, whereas the use of the guard in association with the cabinetry

in the preamble is recited merely in the future tense such as by the use of the words "to prevent" at line one of claim 1. The preamble ends with the recitation of "the guard comprising." The body of the claim does recite the guard's features in the present tense including the panel itself comprising the guard, the upper margin thereof along with its associated acute angle, the trough in the lower margin of the panel and a broadly defined means for temporarily securing the panel. However, even as each of the features recited with respect to the guard itself are recited in the present tense, their respective relationship to the details of the cabinetry recited in the preamble are recited in a potential or future tense such as by the use of the words "to overlay"; "when the panel is attached to the lip, to direct"; "for temporarily securing"; "to dispose"; and "to position." As asserted by the examiner in the answer, representative claim 1 defines, positively, the features of the guard per se, and not any present tense interaction of it with the cabinetry itself as set forth in the preamble. The interactions recited are futuristic and may never occur. The guard itself is claimed in the body of the claim only in the context or environment of use of the sink or cabinetry of the preamble. Correspondingly, there is no positive recitation in representative claim 1 on appeal of

the features of the cabinetry and sink to the guard. Significantly, appellant's arguments as to each of the three rejections under 35 U.S.C. § 102 do not traverse any of the examiner's positions relative to the intended use of the claimed guard.

A different intended use of the same structure as in the prior art does not prohibit a statutory anticipation rejection, for example. Indeed, it has been stated by our reviewing court that "the absence of a disclosure relating to function does not defeat the Board's finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable (case citations omitted)." In re Schrieber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The court concludes at 128 F.3d 1477, 44 USPQ2d 1431-32, that "Schrieber's contention that his structure will be used to dispense popcorn does not have patentable weight if the structure is already known, regardless of whether it has ever been used in any way in connection with popcorn (emphasis added)." Such reasoning obviously applies to rejections under 35 U.S.C. § 103. Schrieber confirms the guidance provided in Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Int. 1987), that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not

differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Note also Ex parte Wikdahl, 10 USPQ2d 1546, 1548 (Bd. Pat. App. & Int. 1989) and In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238, CCPA 1967).

We therefore sustain the rejection of claims 1 and 3 as being anticipated under 35 U.S.C. 102 by Piper, and by Carroll, and by Gray, separately.

On the other hand, we do not sustain the rejection of dependent claim 2 under 35 U.S.C. § 103. Even if we were to agree with the examiner's position as to the combinability of Laird with Carroll, and with the separate combinability of Gray in view of Carroll, further in view of Laird, we would not have arrived at the subject matter of dependent claim 2 on appeal. We are in agreement with appellant's position set forth at pages 8 and 9 of the brief that none of the respective references relied on by the examiner to reject dependent claim 2 under 35 U.S.C. § 103 contain any teaching or suggestion of the securing means at the end of independent claim 1 on appeal comprising a hook and pile fastener.

We also cannot agree either with the examiner's assertion with respect to Laird's teaching as applicable to Carroll and in

turn applicable to the combination with Gray, that Laird's teaching of contact adhesive in any way indicates a hook and pile fastener. As such, we do not agree with the examiner's view expressed at page 6 of the answer that "a hook and pile fastener is one type of contact adhesive." Essentially, the examiner's reasoning is based on backward reasoning and therefore improper hindsight because the examiner has not taken prospectively the teachings in Laird of contact adhesive to persuasively indicate to us along with any other teachings and suggestions of all the other references in combination for each of these rejections under 35 U.S.C. § 103 of a hook and pile fastener. The examiner's reasoning just quoted is reversed from what an acceptable line of reasoning must be within 35 U.S.C. § 103. As stated, it is clearly based upon prohibited hindsight.

In view of the foregoing, we have sustained the rejection of independent claims 1 and 3 on appeal. We have reversed the rejection of dependent claim 2 under 35 U.S.C. § 103. As such, the decision of the examiner rejecting claims 1-3 on appeal is affirmed-in-part.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

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Administrative Patent Judge)	
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)	
Kenneth W. Hairston)	BOARD OF PATENT
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